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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kevin McCarthy

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BANNER & WITCOFF

1001 G STREET N W

SUITE 1100

WASHINGTON, DC 20001

EXAMINER

PESIN, BORIS M

ART UNIT

PAPER NUMBER

2174

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.		Applicant(s)	
	09/940,484		MCCARTHY, KEVIN	
	Examiner		Art Unit	
	Boris Pesin		2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 16-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

This communication is responsive to the amendment filed 02/15/2006.

Claims 16-29 are pending in this application. Claims 16 and 18 are independent claims. In the amendment filed 02/15/2006, claims 16, and 18 were amended and 30 and 31 were added as new. This action is made Final.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In regards to claims 25-29, the specification does not teach what is a "Smart Messaging Specification". The specification simply alludes to Nokia's Smart Messaging Specification, but gives no description. Furthermore it is not clear if the Applicant is referring to a general Smart Messaging Specification, or a specific standard set by Nokia as the specification would lead one to believe.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Kumar (US 5648760).

In regards to claim 30, Kumar teaches one or more computer readable media storing computer executable instructions to perform a method of handling reminders in a mobile communication terminal, wherein a reminder is an electronic message which includes a reminder time and data and a reminder text, said method comprising:

receiving characters input by a user into a text editor of the terminal for providing the reminder text, said text editor stored in a limited memory of the mobile communication terminal, wherein said limited memory stores a reminder application, while not storing a calendar application (Column 6, Lines 48-55);

receiving time information input by the user into a time entry for setting the reminder time (Column 7 Line 60 – Column 8 Line 10);

comparing the time information with a real time clock of the mobile communication terminal (Column 7 Line 60 – Column 8 Line 10, and Column 7, Lines 8-10); and

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alerting a user of the terminal with an alarm when the real time clock has reached the reminder time and date, thereby reminding a user of the terminal that an action should be taken as indicated in the text (Column 7 Line 60 – Column 8 Line 10, and Column 7, Lines 8-10).

Claim 31 is similar in scope to claim 30; therefore it is rejected under similar rationale.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar (US 5648760) in view of Alperovich et al. (US 6119014).

In regards to claim 16, Kumar teaches a method of handling reminders in a hand portable communication terminal comprising a limited memory storing a reminder

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application, and not storing a calendar application, wherein a reminder is an electronic message which includes a reminder time and date and a reminder text which reminds a user of the terminal that an action should be taken as indicated in the text, and wherein the reminder application causes the terminal to generate an alarm alerting a user of the terminal that the action should be taken when the time and date of any reminder is reached, comprising:

manually entering characters into a text editor of the terminal for providing the reminder text (Column 6, Lines 48-55);

entering time information into a time entry for setting the reminder time (Column 7 Line 60 – Column 8 Line 10);

providing real time clock information from a clock application (Column 7 Line 60 – Column 8 Line 10);

comparing the time information with the real time clock information (Column 7 Line 60 – Column 8 Line 10);

alerting a user of the terminal with an alarm when the real time clock has reached the reminder time and date (Column 7 Line 60 – Column 8 Line 10, and Column 7, Lines 8-10).

Kumar does not teach transmitting the reminder to a remote second communication terminal via a wireless communication network. However Kumar does teach the use of a modem to transfer information (Column 8, Lines 27-33). Alperovich teaches, "The SMS Service Center 360 can have a SMS-org application 370 located therein, which can receive the SMS messages 320 and associated reminder indicators

315 from the originating subscriber 380 and store them in a memory 375 within the SMS Service Center 360 until the time associated with the reminder indicator is reached. Thereafter, the SMS Service Center 360 can send the SMS message 320 to the MS 300 for display on the MS display 304." (Column 4, Line 66). It would have been obvious to one of ordinary skill in the art to modify Kumar with the teachings of Alperovich and include a reminder transmitting mechanism to other units with the motivation to provide the user with a convenient method of reminding others of tasks that need to be accomplished (See Column 3, Line 15).

In regards to claim 17, which is dependent on claim 16, Kumar teaches that the alerting comprises display of the reminder text (Column 7 Line 60 – Column 8 Line 10, and Column 7, Lines 8-10).

As per independent claim 18, Kumar teaches a handportable communication terminal, comprising:

a control unit (See Figure 1),

a user interface including a display and text input means with said user interface being controlled by the control unit for generating reminders wherein a reminder is an electronic message which includes a reminder time and date and a reminder text which reminds a user of the terminal that an action should be taken as indicated in the text and which causes the terminal to generate an alarm alerting a user of the terminal that the action should be taken when the time and date is reached (Column 7 Line 60 – Column 8 Line 10, and Column 7, Lines 8-10),

memory storing a clock application controlled by the control unit and having a clock function and a storing a reminder application which the display can present (Column 7 Line 60 – Column 8 Line 10, and Column 7, Lines 8-10), the reminder application including a text editor window in which the user through the user interface enters a reminder text label (Column 7 Line 60 – Column 8 Line 10, Column 7, Lines 8-10, and Figure 1, Element 81), and a time entry window in which the user through the user interface enters a date and time for the reminder text is displayed by the (Column 7 Line 60 – Column 8 Line 10, and Column 7, Lines 8-10), and an alert unit that generates an alarm which alerts the user when the clock reaches the entered date and time for the reminder (Column 7 Line 60 – Column 8 Line 10, and Column 7, Lines 8-10).

and wherein the handportable communication terminal does not provide a calendar application (there is no calendar in Kumar).

Kumar does not teach that the reminder application allows the user to transmit the reminder to a remote second communication terminal via a wireless communication network. However Kumar does teach the use of a modem to transfer information (Column 8, Lines 27-33). Alperovich teaches, "The SMS Service Center 360 can have a SMS-org application 370 located therein, which can receive the SMS messages 320 and associated reminder indicators 315 from the originating subscriber 380 and store them in a memory 375 within the SMS Service Center 360 until the time associated with the reminder indicator is reached. Thereafter, the SMS Service Center 360 can send the SMS message 320 to the MS 300 for display on the MS display 304."



(Column 4, Line 66). It would have been obvious to one of ordinary skill in the art to modify Kumar with the teachings of Alperovich and include a reminder transmitting mechanism to other units with the motivation to provide the user with a convenient method of reminding others of tasks that need to be accomplished (See Column 3, Line 15).

As per claim 19, which is dependent on claim 18, Kumar teaches a clock application providing real time clock information to the reminder application, and said reminder application displays a reminder note when the real time clock has reached the reminder time (Column 7 Line 60 – Column 8 Line 10, and Column 7, Lines 8-10).

As per claim 20, which is dependent on claim 18, Kumar teaches that the reminder application provides the user access to add new reminders, view all existing reminders, and erase existing reminders Column 7 Line 51 – Column 8 Line 22).

Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar (US 5648760) in view of Alperovich et al. (US 6119014) further in view of Nokia 6100 User's Guide, 9351506, Issue 2

("Nokia," [http://nds1.nokia.com/phones/files/guides/6110\\_usersguide\\_en.pdf](http://nds1.nokia.com/phones/files/guides/6110_usersguide_en.pdf), June 7<sup>th</sup>, 1998).

As per claim 21, which is dependent on claim 18, Kumar and Alperovich teach all the limitations of claim 18. They do not teach a terminal wherein the reminder application upon receiving instructions to send a reminder requests the user to enter a phone number of the second communication terminal which is to receive the reminder.

Nokia teaches a terminal wherein the reminder application upon receiving instructions to send a reminder requests the user to enter a phone number of the second communication terminal which is to receive the reminder (page 53, column 2, lines 1-4). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kumar and Alperovich with the teachings of Nokia and include a way of requesting the user to enter a phone number of the second communication terminal which is to receive the reminder with the motivation to provide user a convenient method of contacting other users.

As per claim 22, which is dependent on claim 18, Kumar, Alperovich, and Nokia teach all the limitations of claim 21. Nokia further teaches a terminal wherein the reminder application allows the user to search for the phone number of the second communication terminal in an internal phone number database of the transmitting terminal (page 20, column 1, lines 16-24, *user can search a phone number database to find phone numbers*).

As per claim 23, Kumar, Alperovich and Nokia teach all the limitations of claim 21. Nokia further teaches that the reminder application allows the user to inspect a reminder received from a remote second communication terminal via a wireless communication network (page 53, column 2, lines 1-5, *reminders can be sent as messages* and page 32, column 1, lines 6-15, *messages can be received on handportable device*).

As per claim 24, Kumar, Alperovich and Nokia teach all the limitations of claim 21. Nokia further teaches that the reminder application furthermore allows the user to

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save or discard a reminder received from a remote second communication terminal  
(page 32, column 2, lines 7-10 and page 32, column 1, lines 15-25).

Claims 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
Kumar (US 5648760) in view of Alperovich et al. (US 6119014) in view of Nokia 6100  
User's Guide, 9351506, Issue 2

("Nokia," [http://nds1.nokia.com/phones/files/guides/6110\\_usersguide\\_en.pdf](http://nds1.nokia.com/phones/files/guides/6110_usersguide_en.pdf),  
June 7<sup>th</sup>, 1998) further in view of Mercer et al. ("Mercer," US006167429A).

As per claim 25, which is dependent on claim 21, the teachings of Kumar,  
Alperovich, and Nokia in regards to claim 21 have been discussed above. Kumar,  
Alperovich, and Nokia do not explicitly disclose that the reminders are transferred via  
the wireless communication network included in a message according to the Smart  
Messaging Specification.

Mercer teaches that the reminders are transferred via the wireless  
communication network included in a message according to the Smart Messaging  
Specification (column 1, lines 38-48). It would have been obvious to one of ordinary  
skill in the art at the time the invention was made to modify the teachings of Kumar,  
Alperovich, and Nokia with a means to send communications according to the Smart  
Messaging Specification, as taught by Mercer, with the motivation to enable access to a  
range of text based services from a mobile phone and therefore provide the user with  
more options for communication (column 1, lines 41-42).

Claims 26-29 are similar in scope to claim 25, and are therefore rejected under similar rationale.

### ***Response to Arguments***

Applicant's arguments with respect to claims 16-29 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Pesin whose telephone number is (571) 272-4070. The examiner can normally be reached on Monday-Friday except every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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